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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,371	03/09/2004	Adam J. Katz	30448.77USD1	4480
26941 7590 02/26/2007 MANDEL & ADRIANO 55 SOUTH LAKE AVENUE SUITE 710 PASADENA, CA 91101			EXAMINER GARVEY, TARA L	
			ART UNIT	PAPER NUMBER
			1636	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/797,371		KATZ ET AL.	
	Examiner		Art Unit	
	Tara L. Garvey		1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/1/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 are pending. Receipt is acknowledged of an amendment file don November 21, 2006 in which claims 39, 40, 160 were amended, new claims 169-182 were added and claims 1, 3-13, 36=38, 49-56, 58-65, 73, 74, 77-79, 132-159 and 163-168 were canceled.

Response to Arguments

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for reasons of record as set forth in the office action mailed on May 5, 2006. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This rejection is maintained and applied to the new claims as amended.**

Applicant's argue that the current amendment to the claims render the rejection moot.

In response to applicant's arguments, the addition of the limitation of "clonally" to the isolated adipose-derived stem cell does render the rejection for written description

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moot. A structural and functional relationship for all of the characteristics of a clonally isolated adipose derived stem cell that allow it to function as a stem cell that can develop into any mesodermal tissue is still not provided.

Claims 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for reasons of record as set forth in the office action mailed on May 5, 2006 and above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons of record as set forth in the office action mailed on May 5, 2006. **This rejection is repeated below and applied to the new claims added in the amendment.**

The metes and bounds of the claimed subject matter are not defined. The word "derived" is unclear since it does not define the scope of the limitations. Without a clear statement of the process by which the starting material is derivatized it is not possible to know the metes and bounds of such a limitation because any given starting material can have many divergent derivatives depending on the process of derivatization.

The applicant has not responded to this rejection. Therefore, this rejection is maintained.

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Claims 39-42, 44, 45, 47, 48, 57 and 160-162 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

The rejection of claims 39, 40, 41, 45, 57 and 160 under 35 U.S.C. 102(e) as being anticipated by Halvorsen et al (US 2002/0119126; made of record in the office action mailed August 9, 2005) is withdrawn.

Claim Rejections - 35 USC § 103

The rejection of claim 161 under 35 U.S.C. 103(a) as being unpatentable over Halvorsen et al (US 2002/0119126; made of record in the office action mailed August 9, 2005) in view of Golde et al (US 4,438, 032; made of record in the office action mailed August 9, 2005) is withdrawn.

The rejection of claim 162 under 35 U.S.C. 103(a) as being unpatentable over Halvorsen et al (US 2002/0119126; made of record in the office action mailed August 9, 2005) in view of Gimble et al (US 6,555,374; made of record in the office action mailed August 9, 2005) is withdrawn.

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Double Patenting

The provisional rejection of claims 39-42, 44, 45, 67, 48 and 160 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 58-60, 67, 76-78, 80, 81, 83 and 84 of copending Application No. 10/845,315 is withdrawn.

New Grounds of Rejection

These new rejection were necessitated by applicant's amendment.

Claim Objections

Claim 40 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim limits the invention to any of an adipogenic, osteogenic, chondrogenic and myogenic medium, which are already claimed in independent claim 39.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 40 and 178 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 40, the metes and bounds of the claimed invention are unclear. How will further limiting the invention to using a medium that is dermatogenic, embryonic, fetal or stromogenic result in differentiating the stem cell into a in a fat, bone, cartilage or muscle cell?

Regarding claim 178, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L Garvey whose telephone number is (571) 272-2917. The examiner can normally be reached on Monday through Friday 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) (<http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that

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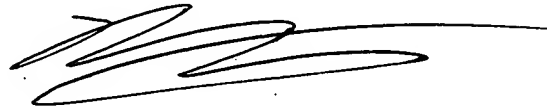
the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Tara L Garvey, Ph.D.
Examiner
Art Unit 1636

TLG

CELINE QIAN, PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke at the end, positioned below the printed name of the primary examiner.